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10/715,395

11/19/2003

Naoko Ono

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09/06/2005

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

BALAOING, ARIEL A

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                            |  |
|------------------------------|-------------------------------|----------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/715,395 | Applicant(s)<br>ONO ET AL. |  |
|                              | Examiner<br>Ariel Balaoing    | Art Unit<br>2683           |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by FOGEL (WO 01/50151 A1).

Regarding claim 1, FOGEL discloses an apparatus used in a mobile communication system with a plurality of wireless base stations (page 20, lines 1-13), comprising: an acquiring unit configured to acquire identification information of said wireless base stations (page 15, lines 6-13); a location detecting unit configured to detect a present location of the apparatus upon acquiring at least one of identification information of said wireless base stations (page 15, lines 14-24; page 15, line 23-page 16, line 11); an storing unit configured to store the acquired identification information being associated with the detected present location of said apparatus (page 15, lines 6-24; page 20, lines 1-13; memory of some form is inherently necessary to store acquired data); a location information providing unit configured to figure a location of said wireless base stations using the detected present location of said apparatus stored in said storing unit and to provide the figured location of said wireless base stations (page 20, lines 1-13; current position is displayed in correlation to wireless base stations locations).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses wherein said location information providing unit having map information [navigational display], configured to add information of said figured location of said wireless base stations to the map information (page 20, lines 1-13).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses wherein said location information providing unit configured to display the map information indicating said figured location of said wireless base stations (page 20, lines 1-13).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses further comprising a cellular telephone unit configured to perform cellular communication with a cellular base station being a part of a cellular network (abstract; cellular telephones are inherently configured to communicate with cellular base stations).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses wherein said acquiring unit configured to acquire identification information of said wireless base stations which is included in a signal transmitted from said wireless base stations (page 15, lines 14-24; page 15, line 23-page 16, line 11).

Regarding claim 9, FOGEL discloses a method for mapping location information of a wireless base station which provides contents data to a mobile communication terminal (page 20, lines 1-13), comprising: acquiring identification information of said

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wireless base stations (page 15, lines 6-13); detecting a location of said terminal (page 15, lines 14-24; page 15, line 23-page 16, line 11); storing the acquired identification information of said wireless base stations being associated with the detected location of said terminal (page 15, lines 14-24; page 15, line 23-page 16, line 11); figuring the location of said wireless base stations based on the detected terminal location associated with the acquired identification information of said wireless base stations (page 15, lines 14-24; page 15, line 23-page 16, line 11; page 20, lines 1-13); and providing map information indication information of the figured location of said wireless base stations (page 20, lines 1-13).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses a mobile terminal communicatable with a plurality of wireless base stations (page 20, lines 1-13), comprising: a receiver which receives an identification data of at least one of base stations (page 15, lines 6-13); a location detector which detect a present location data of the terminal when the identification data is received (page 15, lines 14-24; page 15, line 23-page 16, line 11); a memory to store the identification data associated with the present location data (page 15, lines 6-24; page 20, lines 1-13; memory of some form is inherently necessary to store acquired data); a map generating unit configured to generate a map showing the present position of the terminal among base stations, using the identification data with the present location data from the memory (page 20, lines 1-13); and a display [navigational display] to show the map (page 20, lines 1-13).

***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 5, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over FOGEL (WO 01/50151 A1) in view of SCHMIDT et al (US 2004/0056798 A1).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, FOGEL does not disclose wherein said mobile communication system is a wireless local area network system being compliant with a standard of IEEE 802.11. SCHMIDT discloses wherein said mobile communication system is a wireless local area network system being compliant with a standard of IEEE 802.11 (paragraph 16). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify FOGEL to include IEEE 802.11 protocols to the system, as taught by SCHMIDT, as FOGEL discloses the use of Bluetooth which is another short range radio communication technology. This is beneficial in that 802.11 generally includes support for a wider area of coverage then Bluetooth.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, FOGEL does not disclose further comprising a communication unit configured to communicate with said wireless base stations, said communication unit being adapted to a standard of IEEE 802.11. SCHMIDT discloses further comprising a communication unit configured to communicate with said wireless base stations, said communication unit being adapted to a standard of IEEE 802.11 (paragraph 16). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify FOGEL to include IEEE 802.11 protocols to the system, as taught by SCHMIDT, as FOGEL discloses the use of Bluetooth which is another short range radio communication

technology. This is beneficial in that 802.11 generally includes support for a wider area of coverage than Bluetooth.

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. FOGEL further discloses wherein said acquiring device configured to acquire identification information of said wireless base stations which is included in a signal transmitted from said cellular base station (page 15, lines 14-24; page 15, line 23-page 16, line 11).

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, FOGEL does not disclose wherein said mobile communication terminal is adapted to a standard of IEEE 802.11. SCHMIDT discloses wherein said mobile communication terminal is adapted to a standard of IEEE 802.11 (paragraph 16). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify FOGEL to include IEEE 802.11 protocols to the system, as taught by SCHMIDT, as FOGEL discloses the use of Bluetooth which is another short range radio communication technology. This is beneficial in that 802.11 generally includes support for a wider area of coverage than Bluetooth.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WON et al (US 6754488 B1) - System and method for detecting and locating access points in a wireless network.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Art Unit 2683  
Patent Examiner

AB

  
RAFAEL PEREZ-GUTIERREZ  
PATENT EXAMINER  
8/31/05